

U.S.S.N. 09/765,491

Filed: 1617

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

An election of species requirement, if necessary, should be made in the first Office Action, before a search of the prior art has been conducted. See 37 C.F.R. 1.146. The limitations listing the angiogenesis factors have been in the claims throughout the prosecution of the application. Two Office Actions on the merits have been mailed during the prosecution of this application; the first is dated November 11, 2001, and the second is dated August 13, 2002.

An election of species may be required if an application contains generic claims and claims to more than one patentably distinct species. The patent rules explain that in this situation, “[i]n the *first* Office Action [...] the examiner may require the applicant in the reply to that action to elect a species of his or her invention.” 37 C.F.R. § 1.146 (emphasis added) Similarly, M.P.E.P. § 808.01 (a) states that “[e]lection of species *should be required prior to a search on the merits* [...] in all applications containing both species claims and generic or Markush claims.” (emphasis added) Thus the rules and guidelines for the U.S. Patent Office clearly require an election of species, if necessary, in the first office action, prior to any search for prior art. Therefore the Examiner cannot wait until after the second Office Action on the merits to issue an election of species requirement.

Applicants have found no basis in the patent rules or laws or in the M.P.E.P. for making *an election of species* after the first office action. Further, the Examiner has not cited any source to justify the election of species requirement so late in the prosecution of this application.

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Favorable consideration of claims 4-6, 10-12, and 17-19 is earnestly solicited.

Respectfully submitted,

Rivka D. Monheit
Rivka D. Monheit
Reg. No. 48,731

Date: March 6, 2003

HOLLAND & KNIGHT LLP
One Atlantic Center, Suite 2000
1201 West Peachtree Street
Atlanta, Georgia 30309-3400
(404) 817-8514
(404) 817-8588 (fax)

Certificate of Facsimile Transmission

I hereby certify that this Response to Election of Species Requirement, and any documents referred to as attached therein are being facsimile transmitted on this date, March 6, 2003, to the Commissioner for Patents, U.S. Patent and Trademark Office, Washington, DC 20231.

Pam Turnbough
Pam Turnbough

Date: March 6, 2003

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CLAIMS AS PENDING

4. (three times amended) A method for inhibiting symptoms associated with angiogenesis in the treatment of skin disorders selected from the group consisting of lymphangiogenesis, Sturge-Weber syndrome, verruca vulgaris, neurofibromatosis, tuberous sclerosis, venous ulcers, molluscum contagious, seborrheic keratosis, and actinic keratosis comprising administering to the individual in need of treatment thereof an angiogenesis inhibitor wherein the angiogenesis inhibitor is selected from the group consisting of collagenase inhibitors, angiogenic fumagillin derivatives, 2,5-diaryl tetrahydrofurans, aminophenylphosphonic acid compounds, 3-substituted oxindole derivatives, thalidomides, penicillamine and IL12 in an amount effective to inhibit angiogenesis.

5. The method of claim 4 wherein the angiogenesis inhibitor is applied topically.

6. (amended) The method of claim 5 wherein the angiogenesis inhibitor is TNP-470.

10. (twice amended) A method to treat the symptoms associated with elevated basic fibroblast growth factor in a disorder selected from the group consisting of angiosarcoma, hemangioendothelioma, malignant melanoma and Karposi's sarcoma, comprising administering to the individual in need of treatment an effective amount of a curcuminoid to inhibit angiogenesis.

11. (amended) The method of claim 10 wherein the curcuminoid is curcumin.

12. (amended) The method of claim 10 wherein the curcuminoid is demethoxycurcumin.

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17. (twice amended) A method for inhibiting skin disorders selected from the group consisting of lymphangiogenesis, hemangioma of childhood, Sturge-Weber syndrome, *verruca vulgaris*, neurofibromatosis, tuberous sclerosis, pyogenic granulomas, recessive dystrophic epidermolysis bullosa, venous ulcers, rosacea, eczema, *molluscum contagious*, seborrheic keratosis, and actinic keratosis comprising administering to the individual in need of treatment thereof an angiogenesis inhibitor in an amount effective to inhibit angiogenesis, wherein the angiogenesis inhibitor is selected from the group consisting of tetracyclines inhibiting collagenase, and a sulfated polysaccharide which inhibits angiogenesis.

18. The method of claim 10 wherein the disorder is malignant melanoma.

19. The method of claim 10 wherein the disorder is recessive dystrophic epidermolysis bullosa.

ATL1 #393498 v1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: **Jack L. Arbiser**

Serial No.: **09/765,491** Art Unit: **1617**

Filed: **January 18, 2001** Examiner: **J. Kim**

For: ***CURCUMIN AND CURCUMINOID INHIBITION OF ANGIOGENESIS***

Assistant Commissioner for Patents
Washington, D.C. 20231

PETITION FOR SUPERVISORY REVIEW BY THE COMMISSIONER

Sir:

Responsive to the Office Action mailed on February 12, 2003, please consider the following petition. In addition to this Petition, Applicants are filing a Response to Election of Species Requirement. It is believed that no fee is required with this submission. However, should a fee be required, the Commissioner is hereby authorized to charge the fee to Deposit Account No. 50-1868.

Remarks

Applicants respectfully request that the Commissioner exercise supervisory authority in the prosecution of the pending application, as allowed under 37 C.F.R. §1.181 (a) (3).

In the Office Action dated February 12, 2003, the Examiner required an election of species from among the angiogenesis inhibitors listed in claims 4, 10 and 17. An election of species requirement, if necessary, should be made in the first Office Action, before a search of

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the prior art has been conducted. *See* 37 C.F.R. 1.146 The limitations listing the angiogenesis factors have been in the claims throughout the prosecution of the application. Two Office Actions on the merits have been mailed during the prosecution of this application; the first is dated November 11, 2001, and the second is dated August 13, 2002.

An election of species may be required if an application contains generic claims and claims to more than one patentably distinct species. The patent rules explain that in this situation, “[i]n the *first* Office Action [...] the examiner may require the applicant in the reply to that action to elect a species of his or her invention.” 37 C.F.R. § 1.146 (emphasis added) Similarly, M.P.E.P. § 808.01 (a) states that “[e]lection of species *should be required prior to a search on the merits* [...] in all applications containing both species claims and generic or Markush claims.” (emphasis added) Thus the rules and guidelines for the U.S. Patent Office clearly require an election of species, if necessary, in the first office action, prior to any search for prior art. Therefore the Examiner cannot wait until after the second Office Action on the merits to issue an election of species requirement.

Applicants have found no basis in the patent rules or laws or in the M.P.E.P. for making an *election of species* after the first office action. Further, the Examiner has not cited any source to justify the election of species requirement so late in the prosecution of this application.

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Applicants respectfully request removal of the election of species requirement, and consideration of and allowance of claims 4-6, 10-12, and 17-19.

Respectfully submitted,

Rivka D. Monheit
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Reg. No. 48,731

Date: March 6, 2003

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APPENDIX: *Clean Copy of Claims as Pending*

4. (three times amended) A method for inhibiting symptoms associated with angiogenesis in the treatment of skin disorders selected from the group consisting of lymphangiogenesis, Sturge-Weber syndrome, verruca vulgaris, neurofibromatosis, tuberous sclerosis, venous ulcers, molluscum contagious, seborrheic keratosis, and actinic keratosis comprising administering to the individual in need of treatment thereof an angiogenesis inhibitor wherein the angiogenesis inhibitor is selected from the group consisting of collagenase inhibitors, angiogenic fumagillin derivatives, 2,5-diaryl tetrahydrofurans, aminophenylphosphonic acid compounds, 3-substituted oxindole derivatives, thalidomides, penicillamine and IL12 in an amount effective to inhibit angiogenesis.

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6. (amended) The method of claim 5 wherein the angiogenesis inhibitor is TNP-470.

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tetracyclines inhibiting collagenase, and

a sulfated polysaccharide which inhibits angiogenesis.

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